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09/296,276	04/22/1999	ROLF SCHUMACHER	225/47721	8165

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EXAMINER
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LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

23

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/296,276

Applicant(s)

SCHUMACHER, ROLF

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-36 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 27-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 56005747 as characterized by the definition of “stamping” set forth on pgs 1130-1131 of Webster’s II: New Riverside University Dictionary. JP 56005747 teach the claimed process including manufacturing a covering or trim part with directly molded-on carrier (figs 1-3); placing a decor part into an at least two-part injection mold (figs 1-3); closing the mold, thereby cutting the decor part to precise contours in the injection mold by shearing off an outer portion of the décor part (figs 1-3); pressing the decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening (figs 1-3); connecting the injection molding compound with the decor part during hardening of the molding compound (figs 1- 3); and opening the injection mold and removing the covering or trim part and molded-on carrier (figs 1-3)--as a note, such is inherent in order to produce a product useable by consumers. JP 56005747 also teaches simultaneously cutting and stamping the decor part. Webster’s II: New Riverside University Dictionary discloses the definition of “stamping” as forming or cutting out by application of a mold, form, or die. The process of JP 56005747 includes a step of forming or cutting out by application of a mold, form, or die.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264). In regard to independent claim 4, JP 56005747 teach the basic claimed including manufacturing a covering or trim part with directly molded-on carrier (figs 1-3); placing a decor part into an at least two-part injection mold (figs 1-3); closing the mold, thereby cutting the decor part to precise contours in the injection mold by shearing off an outer portion of the décor part (figs 1-3); pressing the decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening (figs 1-3); connecting the injection molding compound with the decor part during hardening of the molding compound (figs 1-3); and opening the injection mold and removing the covering or trim part and molded-on carrier (figs 1-3)—as a note, such is inherent in order to produce a product useable by consumers. However, JP 56005747 does not teach using a veneer wood layer. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which is glued to another wood veneer (blind veneer) (figs 1-9). JP 56005747 and Kato et al are combinable because they are analogous with respect to molding a decorative part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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substitute a sheet of the decor part of Kato et al for the decor part of JP 56005747 in order to form a diverse product such as an automobile covering or trim part having a wood veneer appearance. In regard to claims 2-3, 5-7, and 10, JP 56005747 does not teach the specific injection molding temperature and the specific mold temperature; placing a nonwoven coating saturated with phenol melamine resin and a layer of glue on the veneer wood layer; placing a layer of glue on the veneer wood layer; and placing a layer of blind veneer on the veneer wood layer. In regard to the specific injection molding temperature, molding temperature is well-known in the molding art as important molding parameters that is dependent on the molding material, preform material, and equipment. Further, the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Furthermore, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to injection mold at the claimed temperature in order to effectively connect the decor part to the molding compound. In regard to the specific mold temperature, mold temperature is well-known in the molding art as important molding parameters and the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the injection mold of JP 56005747 at the claimed temperature in order to effectively mold a high quality injection

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molded covering or trim part. In regard to placing a nonwoven coating saturated with phenol melamine resin on the veneer wood layer, such is well-known in the molding art as a substitutable alternative for a metal layer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the claimed nonwoven coating for the metal layer of JP 56005747 (modified) in order to reduce cost and further diversify the covering or trim part of JP 56005747. In regard to placing a layer of blind veneer on the veneer wood layer, such is taught by the above combination of JP 56005747 and Kato et al.

5. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Conner (USPN 4369157). JP 56005747 teaches the basic claimed process including manufacturing a covering or trim part with directly molded-on carrier (figs 1-3); placing a decor part into an at least two-part injection mold (figs 1-3); closing the mold, thereby cutting the decor part to precise contours in the injection mold by shearing off an outer portion of the décor part (figs 1-3); pressing the decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening (figs 1-3); connecting the injection molding compound with the decor part during hardening of the molding compound (figs 1- 3); and opening the injection mold and removing the covering or trim part and molded-on carrier (figs 1-3)--as a note, such is inherent in order to produce a product useable by consumers. However, JP 56005747 does not teach using a decor part comprised of a sheet metal part; applying a coupling layer to the backside of the sheet metal part; and heating or activating the coupling layer with the injection molding compound. Conner teaches injection molding

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a covering having a decor part comprised of a sheet metal part with a coupling layer (adhesive layer) attached to a backside thereof; heating or activating the coupling layer with the injection molding material (col 5, lns 38-41; col 10, lns 1-35); using a reactive hot melt type adhesive or dry glue film (col 10, lns 1-35). JP 56005747 and Conner are combinable because they are analogous with respect to injection molding against a sheet preform to create a decorative article. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the decor part of Conner for the decor part of JP 56005747 in order to further diversify the decorative molding of JP 56005747.

6. Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264) as applied to claim 4 and further in view of Stickling (USPN 5525179). The above teachings of JP 56005747 and Kato et al are incorporated hereinafter. JP 56005747 does not teach embedding fastening elements in the injection-molded compound. Stickling teaches injection molding a covering or trim part having embedded fastening elements therein (figs 5-7). JP 56005747 and Stickling are combinable because they are analogous with respect to injection molding covering or trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to embed fastening elements as taught by Stickling in the injection molding compound of JP 56005747 in order to securely attach fastening elements to the covering of JP 56005747.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264). JP 56005747 teach the basic claimed

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process including manufacturing a covering or trim part with directly molded-on carrier (figs 1-3); placing a decor part into an at least two-part injection mold (figs 1-3); closing the mold, thereby moving a cutting edge provided on a first part of the mold past an inside wall area of a second part of the mold and thereby cutting the decorative part to a precise shape by shearing off an outer edge of the decorative part figs 1-3); injecting an injection molding compound into the mold after cutting the decorative part, which upon curing permanently bonds to the decorative part (figs 1-3); opening the mold and removing the covering or trim part and mold-on carrier (figs 1-3)--as a note, such is inherent with the process in order to produce a product useable by consumers.

However, JP 56005747 does not teach using a veneer wood layer or sheet metal part. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which is glued to another wood veneer (blind veneer) (figs 1-9). JP 56005747 and Kato et al are combinable because they are analogous with respect to molding a decorative part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the decor part of JP 56005747 in order to form a diverse product such as an automobile covering or trim part having a wood veneer appearance. In regard to claim 36, JP 56005747 also teaches simultaneously cutting and stamping the decor part.

8. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264). The above teachings of JP 56005747 in view of Kato et al are incorporated hereinafter. JP 56005747 does not teach the



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specific injection molding temperature and the specific mold temperature. In regard to the specific injection molding temperature, molding temperature is well-known in the molding art as an important molding parameter that is dependent on the molding material, preform material, and equipment. Further, the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Furthermore, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to injection mold at the claimed temperature in order to effectively connect the decor part to the molding compound. In regard to the specific mold temperature, mold temperature is well-known in the molding art as important molding parameters and the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the injection mold of JP 56005747 at the claimed temperature in order to effectively mold a high quality injection molded covering or trim part.

9. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264). The above teachings of JP 56005747 in view Kato et al are incorporated hereinafter. JP 56005747 does not teach placing a nonwoven coating saturated with phenol melamine resin and a layer of glue on the veneer wood layer; placing a layer of glue on the veneer wood layer; and placing a layer

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of blind veneer on the veneer wood layer. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which glued to another wood veneer (blind veneer) (figs 1-9). JP 56005747 and Kato et al are combinable because they are analogous with respect to molding a decorative part.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the decor part of JP 56005747 in order to form a diverse product such as an automobile covering or trim part having a wood veneer appearance. In regard to placing a nonwoven coating saturated with phenol melamine resin on the veneer wood layer, such is well-known in the molding art as a substitutable alternative for a metal layer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the claimed nonwoven coating for the metal layer of JP 56005747 (modified) in order to reduce cost and further diversify the covering or trim part of JP 56005747.

10. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 in view of Kato et al (USPN 5225264) and further in view of Conner (USPN 4369157). The above teachings of JP 56005747 and Kato et al are incorporated hereinafter. JP 56005747 does not teach using a decor part comprised of a sheet metal part; applying a coupling layer to the backside of the sheet metal part; and heating or activating the coupling layer with the injection molding compound. Conner teaches injection molding a covering having a decor part comprised of a sheet metal part with a coupling layer (adhesive layer) attached to a backside thereof; heating or activating the

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coupling layer with the injection molding material (col 5, Ins 38-41; col 10, Ins 1-35); using a reactive hot melt type adhesive or dry glue film (col 10, Ins 1-35). JP 56005747 and Conner are combinable because they are analogous with respect to injection molding against a sheet preform to create a decorative article. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the decor part of Conner for the decor part of JP 56005747 in order to further diversify the covering or trim part of JP 56005747.

11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 (USPN 5223201) in view of Stickling (USPN 5525179). The above teachings of JP 56005747 are incorporated hereinafter. JP 56005747 does not teach embedding fastening elements in the injection molding compound. Stickling teaches injection molding a covering or trim part having embedded fastening elements therein (figs 5-7). JP 56005747 and Stickling are combinable because they are analogous with respect to injection molding covering or trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to embed fastening elements as taught by Stickling in the injection molding compound of JP 56005747 in order to securely attach fastening elements to the covering of JP 56005747.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56005747 as characterized by the definition of "stamping" set forth on pgs 1130-1131 of Webster's II: New Riverside University Dictionary in view of Kato et al (USPN 5225264). JP 56005747 teach the basic claimed process including manufacturing a covering or trim part with directly molded-on carrier (figs 1-3); placing a decor part into an at least

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two-part injection mold (figs 1-3); closing the mold, thereby moving a cutting edge provided on a first part of the mold past an inside wall area of a second part of the mold and thereby cutting the decorative part to a precise shape by shearing off an outer edge of the decorative part (figs 1-3); injecting an injection molding compound into the mold after cutting the decorative part, which upon curing permanently bonds to the decorative part (figs 1-3); opening the mold and removing the covering or trim part and mold-on carrier (figs 1-3)--as a note, such is inherent with the process in order to produce a product useable by consumers. JP 56005747 also teaches simultaneously cutting and stamping the decor part. Webster's II: New Riverside University Dictionary discloses the definition of "stamping" as forming or cutting out by application of a mold, form, or die. The process of JP 56005747 includes a step of forming or cutting out by application of a mold, form, or die. However, JP 56005747 does not teach using a veneer wood layer or sheet metal part. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which is glued to another wood veneer (blind veneer) (figs 1-9). JP 56005747 and Kato et al are combinable because they are analogous with respect to molding a decorative part. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the decor part of JP 56005747 in order to form a diverse product such as an automobile covering or trim part having a wood veneer appearance.

13. Applicant's arguments filed 5/31/02 have been fully considered but they are not persuasive. Applicant argues for the first time that JP 56005747 does not teach

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simultaneously cutting and stamping the décor part. It is clear from fig 7 of JP 56005747 that the film is simultaneously cut and stamped. Applicant is reminded that stamping is defined as forming or cutting by application of a mold, form, or die. See attached photocopy of pages 1130-1131 of Webster's II: New Riverside University Dictionary. Since Applicant's specification does not define "stamping," the use of the above definition is proper. Applicant also argues there is no motivation to combine JP 56005747 and Kato et al. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes from the knowledge generally available to one of ordinary skill in the art. That is, decorative articles having a wood veneer layer and/or a metal layer are well-known in the art for their aesthetic appeal. Since there is a demand for such decorative products, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the film of Kato et al in the process in the JP 56005747 in order to produce the demanded products with greater efficiency, i.e., no need for separate steps of precisely cutting the preform and inserting the precisely preform into a mold, and precision. Applicant also argues the material of Conner is unsuitable for the process of JP 56005747. Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily

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incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Here, the film material of Conner and not its affect on the process of Conner, i.e., enhanced removability, would have been obvious to use in the process of JP 56005747.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Souder et al (USPN 5629029), JP05269793, JP 09234769, JP 63216717, and JP 62201215 teach the state of insert molding.

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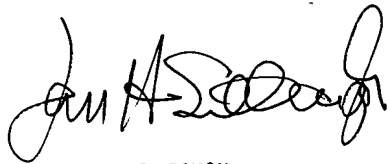
16. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

August 12, 2002

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
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08/12/02